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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,124	09/10/2003	Andrew Michael Duggan	MRKS/0099	3542

7590

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EXAMINER

STEPHENSON, DANIEL P

ART UNIT PAPER NUMBER

3672

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/659,124	Applicant(s) DUGGAN, ANDREW MICHAEL	
	Examiner Daniel P. Stephenson	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,32,35,38,41-44,47,50,54-56,64,67,70 and 73-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/31/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 14-31,33,34,36,37,39,40,48,49,51-53,57-63,65,66,68,69,71,72 and 76-79.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-7, 9-13, 32, 35, 38, 41, 42, 44, 54-56, 64, 67, 70, 73, 75 are rejected under 35 U.S.C. 102(e) as being anticipated by the pre-grant publication '608 to Smith, Jr. et al. Smith, Jr. et al. '608 (Fig. 3-5) discloses a tubing expansion tool with a body and an expansion member (82) radially movably mounted on the body for movement towards an expanded position for expanding tubing to a predetermined diameter. There is an activating member movable within the body (84). The member is lockable in the extended configuration by a locking assembly (74), which mechanically locks the member in the extended position. The locking member is reversible. The activating and locking member can be moved by hydraulic force. The locking member locks the activating member in the activating position. The activating member moves the expansion member into the expanded position through the use of a cam surface. The locking member is adapted to engage the activating member and is coupled to the expansion member. If read broadly the locking member can be considered the notch in which the dog resides, then it would be on the activation member engaging the body. The expansion member is pivoted on the activation member. The expansion member can be expanded and released either within the tubing or outside of it. It can be operated after passing through a restriction in the tubular then

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expanding the tool. It is also discussed as being used in an open hole situation to expand a successive tubular on another.

With regards to claims 35 and 38, these limitations do not apply to the tool and are dependent from a separate entity, namely the tubing that the tool is said to expand. Therefore, unless the tool is positively claimed in combination with the tubing these limitations are given little, if any, patentable weight.

3. Claims 1-3, 5-7-13, 32, 35, 38, 41, 42, 44, 54-56, 64, 67, 70, 73, 75 are rejected under 35 U.S.C. 102(e) as being anticipated by the pre-grant publication '446 to Haugen et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Haugen et al. '446 (Fig. 6, 7 and 10) discloses a tubing expansion tool with a body and an expansion member (752, 792) radially movably mounted on the body for movement towards an expanded position for expanding tubing to a predetermined diameter. There is an activating member movable within the body (780). The member is lockable in the extended configuration by a locking assembly (dogs on expansion members), which mechanically locks the member in the extended position. The locking member is reversible. The activating and locking member can be moved by hydraulic force. The locking member locks the activating member in the activating position. The activating member moves the expansion member into the expanded

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position through the use of a cam surface. The locking member is adapted to engage the activating member and is coupled to the expansion member. If read broadly the locking member can be considered the notch in which the dog resides, then it would be on the activation member engaging the body. The expansion member is pivoted on the activation member. The expansion member can be expanded and released either within the tubing or outside of it. It can be operated after passing through a restriction in the tubular then expanding the tool. It is also discussed as being used in an open hole situation to expand a successive tubular on another. There is a spring configured to bias the activating member toward the deactivating position.

With regards to claims 35 and 38, these limitations do not apply to the tool and are dependent from a separate entity, namely the tubing that the tool is said to expand. Therefore, unless the tool is positively claimed in combination with the tubing these limitations are given little, if any, patentable weight.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Jr. et al. '608 or Haugen et al. '446. Smith, Jr. et al. '608 or Haugen et al. '446 shows all the limitations of the present invention, except it does not explicitly disclose that the locking mechanism is electromechanical in nature. It is officially noticed that an electromechanical locking mechanism is an art recognized equivalent to that of a mechanical or hydraulic locking mechanism. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the mechanical locking assembly of Smith, Jr. et al. '608 or Haugen et al. '446 with an

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electromechanical assembly. This would be done to speed the time of activation or lower costs.

It is noted that this official notice statement was taken in the last action and was not traversed by the applicant. Therefore, the Official Notice is now taken to be admitted Prior Art, see MPEP 2144.03 section C.

6. Claims 43, 47 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Jr. et al. '608 or Haugen et al. '446 in view of Underhill '410. Smith, Jr. et al. '608 or Haugen et al. '446 shows all the limitations of the present invention, except it does not explicitly disclose that the expansion member is mounted on a pivoting arm and is mounted for rotation on the arm or that it has a rotational axis offset from the tool. Underhill '410 (Fig. 17) discloses a pivoting arm with a rotating expansion member located thereon. The rotating expansion member can have an axis offset from the axis of the tool. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the arm of Underhill '410 on the apparatus of Smith, Jr. et al. '608 or Haugen et al. '446. This would be done to allow the expansion with reduced friction on the expansion member since it is allowed to rotate.

7. Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Jr. et al. '608 or Haugen et al. '446 in view of the WIPO document '766 to Simpson et al. (hereafter WIPO '766). Smith, Jr. et al. '608 or Haugen et al. '446 shows all the limitations of the present invention, except they do not show that the apparatus make a bell-bottom indentation in the tubing. WIPO '766 discloses (Fig. 17b) forming a bell-bottom formation in one tubular when attaching another tubular within it, using expansion members. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the apparatus of Smith, Jr. et al. '608 or Haugen et al. '446 to make the bell-bottom tubular of WIPO '766. This would

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be done because it is common to attach expandable tubulars in this manner within the wellbore art.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

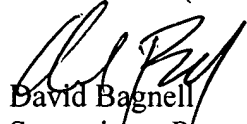
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stephenson whose telephone number is (571) 272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DPS 